

Application Serial No: 09/988,055
Attorney Docket No.: 51948 (ACT-161)

REMARKS

Reexamination and reconsideration of the subject matter identified in caption, in light of the remarks which follow, are respectfully requested.

Claims 1-7 and 9-41 are pending in the application. It is noted that the Office Action Summary incorrectly notes the pending claims as including claims 1-7 and 9-29 only.

Applicants note with appreciation the allowance of claims 1-7, 9-11 and 19-29, and the indication of allowable subject matter with respect to claims 13-18. Applicants believe, however, that the allowed claims should also include claims 30-41, as claim 12 only was rejected. Clarification is respectfully requested.

Applicants thank the Examiner for his time and consideration during the telephonic interview of November 17, 2004. During the interview, the claim discrepancies noted above with respect to the Office Action Summary were discussed. In addition, the art rejection based on *Trott et al* (U.S. Patent No. 5,862,283) was discussed. The arguments presented during the interview are set forth below in the discussion of the rejection.

Turning now to the final Official Action, claim 12 stands rejected under 35 U.S.C. §102(b) as being anticipated by *Trott et al*. This rejection is respectfully traversed for the following reasons.

The present invention relates to optical subassemblies. The subassemblies of claim 12 include an optical device having at least one cut-out portion. A substrate has an upper surface and a plurality of pits. A positioning mechanism is disposed in each of the pits. The positioning mechanisms contact the at least one cut-out portion.

It is well established, that in order to establish anticipation under §102(b), each element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Kalman v. Kimberly-Clark Corp., 218 USPQ 789 (Fed. Cir. 1983). That is not the case here.

Trott et al relates to fiber optics or photonics modules and, more particularly, to a precisely erected planar optical component on a mounting member (col. 1, lines 7-10).

Trott et al does not disclose or suggest each feature of applicants' invention. For example, *Trott et al* does not disclose or fairly suggest positioning mechanisms

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contacting at least one cut-out portion, as set forth in claim 12. In this regard, the Office takes the position that:

[r]egarding claim 12, Trott et al. discloses an optical device having at least one cut-out portion (fig 4, 32, fig. 11, 152); a substrate having an upper surface and a plurality of pits (fig 4, 31, 51, 52); and a positioning mechanism disposed in each said pit (fig 11, 165), wherein said positioning mechanisms contact said at least one cut-out portion. (Official Action at page 2).

Applicants respectfully disagree with the Office's position. Applicants note that the planar optical device 32 and planar optical filter 152 of *Trott et al* cannot properly be deemed cut-out portions. The portion of *Trott et al* relied on in support of a cut-out portion reads as follows:

In an alternative embodiment as shown in FIG. 11, the optical filter 152 may have one saw cut to form a sloping end 166 such that the surface of the sloping end 166 contacts one side wall (i.e., the side wall 163) of the V-shaped groove 161. (Col. 6, line 67 to col. 7, line 3).

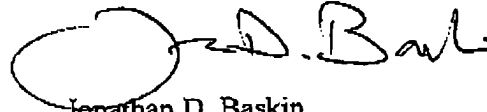
With reference to Figure 11 of *Trott et al* and as discussed during the Examiner Interview, the saw cut portion of optical filter 152 which results in sloping end 161 is not in contact with the push ball 165. Thus, even assuming, *arguendo*, that the sloping sidewall is a cut-out portion within the meaning of applicants' invention, the purported positioning mechanism 165 cannot properly be deemed to contact the cut-out portion. Accordingly, the §102(b) rejection based on *Trott et al* is improper and should be withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

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If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

Respectfully submitted,



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